

## **REMARKS**

In response to the above-identified Office Action, Applicant amends the application and seeks reconsideration thereof. In this response, Applicant amends Claim 3. Applicant does not cancel any claims or add any new claims. Accordingly, Claims 1-5, 7-19, 21 and 22 are pending.

### **I. Claims Rejected Under 35 U.S.C. § 103(a)**

Claims 1-5, 7-19, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,623,637 issued to Jones *et al.* (hereinafter “*Jones*”) in view of U.S. Patent No. 5,754,821 issued to Cripe *et al.* (hereinafter “*Cripe*”). Applicant respectfully disagrees.

As to Claim 1, the first element of Claim 1 recites a method comprising: providing a partition on a storage device of a computer system, wherein said partition is invisible to an operating system of the computer unless the partition is unlocked. The Examiner acknowledges that *Jones* fails to teach this limitation of the current invention, but relies upon *Cripe*, which is said to provide the necessary instruction. However, a careful review of *Cripe* reveals that it does not supply the missing information. Generally, *Cripe* can best be described as explaining a workaround or kludge to defeat the “fencing” system described in U.S. Patent No. 5,128,995 issued to Arnold *et al.* (“*Arnold*”). (See *Cripe*, column 2, lines 22-24.) Although *Cripe* uses the phrase “invisible to the operating system” in its background remarks, other remarks make clear that the “fenced” portion of the storage device is *inaccessible*, not *invisible*. (See *Cripe*, column 1, line 62 through column 2, line 5; *e.g.* “a reference to DASD [Direct Access Storage Device] is rejected as an illegal reference to a protected memory partition.”) A “protected memory partition” is different from a “partition [that] is invisible to an operating system.”

Furthermore, it would not have been obvious to one of ordinary skill in the art to combine *Jones* with *Cripe* because there is no suggestion in either of the desirability of doing so. “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In*

*re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Applicant respectfully submits that no such motivation has been shown.

*Jones* is directed at providing security and protection against unauthorized access for private information on a portable device which may be detached from a computer (*Jones*, column 1, line 61 through column 2, line 4). By contrast, *Cripe* is directed at restoring access to a portion of a storage device that has been “fenced off” or made inaccessible during the computer boot process. These are distinct problems, and in fact, while *Jones* is concerned with *reducing* and *limiting* access to information, *Cripe* is intended to *expand* and *increase* access to information. Therefore, it would seem to be *counterproductive* to combine *Jones* with *Cripe* as the Examiner suggests, and a practitioner would be unlikely to expect to succeed by doing so. For at least these reasons, Applicant believes that Claim 1 is patentable over the references of record, and respectfully requests that the rejection be withdrawn.

As to Claims 2-5, 7-9 and 21, these Claims depend upon Claim 1, which has been shown to be patentable over *Jones* in view of *Cripe* in the discussion above. Thus, for at least those reasons, Applicant requests that the rejection to these dependent claims be withdrawn.

With respect to Claim 10, Claim 10 recites a machine-readable medium that provides instructions, which when executed by a set of processors, causes said set of processors to perform operations including, *inter alia*, unlocking the secure-private partition in response to the unlocking request such that the partition that was previously invisible to an operating system becomes visible to the operating system. The Examiner acknowledges that *Jones* does not teach that the partition that was previously invisible to an operating system becomes visible to the operating system, but relies upon *Cripe* to make up the shortcoming. However, a close reading of *Cripe* reveals that it does not supply the missing information. Generally, *Cripe* can best be described as describing a method to circumvent the “fencing” system described in *Arnold*, particularly in the context of a SCSI controller and SCSI storage device. Although *Cripe* uses the phrase “invisible to the operating system” in its background remarks, other remarks make clear that the “fenced” portion of the storage device is *inaccessible*, not *invisible*. (See *Cripe*, column 1, line 62 through column 2,

line 5; *e.g.* “a reference to DASD [Direct Access Storage Device] is rejected as an illegal reference to a protected memory partition.”) A “protected memory partition” is different from a “partition that was previously invisible to an operating system [but] becomes visible to the operating system.”

For the reasons discussed above, it would not have been obvious to one of ordinary skill to combine *Jones* with *Cripe*, because they address separate and distinct problems, and because *Jones* operates to *restrict* access to information on a storage device, while *Cripe* operates to *facilitate* access to information on a storage device. For at least these reasons, Applicant submits that Claim 10 is allowable over the prior art of record, and respectfully requests that the Examiner withdraw this rejection.

With respect to Claims 11-15, Claims 11-15 depend upon Claim 10, which was shown to be patentable in the discussion above. For at least the reasons mentioned, Applicant requests that the rejection of these claims be withdrawn.

With respect to Claim 16, Claim 16 recites a system comprising, *inter alia*, a storage device having a storage controller which has at least one secure-private partition, wherein the secure-private partition is invisible to an operating system when it is locked and visible to the operating system when it is unlocked. *Jones* does not teach the invisible/visible limitation of Claim 16, and the Examiner’s reliance on *Cripe* for that teaching is unavailing. As previously discussed, *Cripe* employs the phrase “invisible to the operating system,” but other remarks make clear that the “fenced” portion of the storage device is *inaccessible*, not *invisible*. (See *Cripe*, column 1, line 62 through column 2, line 5; *e.g.* “a reference to DASD [Direct Access Storage Device] is rejected as an illegal reference to a protected memory partition.”) This is hardly surprising, in view of *Cripe*’s central thrust as a method of restoring access to a SCSI partition that has been rendered inaccessible by a fencing method such as that described by *Arnold*. Again, Applicant observes that a “protected memory partition” is different from a “partition that was previously invisible to an operating system [but] becomes visible to the operating system.” For at least these reasons,

Applicant submits that Claim 16 is allowable over the prior art of record, and respectfully requests that the Examiner withdraw this rejection.

With respect to Claims 17-19 and 22, these Claims depend upon Claim 16, which was shown to be patentable in the discussion above. For at least the reasons mentioned, Applicant requests that the rejection of these claims be withdrawn.


### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-5, 7-19, 21 and 22 patentably define the subject invention over the prior art of record, and are in condition for allowance. Such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

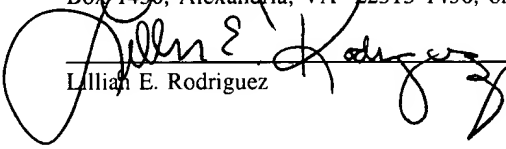
Dated: 8/30, 2004

  
Thomas M. Coester, Reg. No. 39,637

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, California 90025  
(310) 207-3800

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Lillian E. Rodriguez

August 30, 2004